

REMARKS

By this Amendment, Applicant has canceled claim 2 without prejudice or disclaimer, amended claim 1, and added new claim 26. No new matter has been added. Claims 1 and 3-26 are present in the application and are pending on the merits.

Applicant respectfully notes that the Office Action Summary indicates that claims 9 and 19 have been rejected. The body of the Office Action, however, does not include any rejection of those claims. If the Examiner intends to maintain any rejection of those claims following consideration of this Amendment, Applicant respectfully requests that the Examiner fully explain such rejection(s) and make the Office Action containing any such rejection(s) non-final so that Applicant will be provided with an opportunity to respond to such rejection(s).

Section 102(b) Rejection of Independent Claim 1

In the Office Action, claims 1 and 2 were rejected under 35 U.S.C. § 102(b) based on Pflueger et al. (U.S. Patent No. 6,123,198). By this Amendment, Applicant has amended independent claim 1 and canceled claim 2 without prejudice or disclaimer, thereby obviating that rejection of those claims, as discussed in more detail below.

The M.P.E.P. provides that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” § 2131 (citation omitted).

Applicant’s independent claim 1, as amended, recites a cosmetic product including, among other recitations, “a cosmetic composition contained in [a] recess of [a] foam core, the cosmetic composition comprising a cosmetic substance contained

within a tray” The Pflueger et al. reference neither expressly nor inherently discloses at least that subject matter recited in Applicant’s independent claim 1.

The rejection statement asserts that the Pflueger et al. reference discloses, among other things, “a cosmetic container (fig. 2) [and] a covering material (22) covering at least a portion of [a] foam core and defining an exterior surface of [a] cosmetic product” Office Action at 2. Concerning the rejection of dependent claim 2, the rejection statement asserts that Pflueger et al. discloses “a cosmetic substance contained within a tray (it is noted that lipstick substance contained within a tray or tube).” Id.

Applicant respectfully disagrees with the rejection statement’s assertion about what the Pflueger et al. reference discloses. Looking to the reference itself, the Pflueger et al. reference discloses an apparatus 10 for carrying cosmetics, including a cup member 16, a holder member 14, and a cover 12. The cup member 22 may be formed of a polymeric material such as vinyl, has a closed first end and an open second end, and defines a hollow space therebetween. The holder member 14 may be formed from polymeric foam, is sized and adapted to be placed in the hollow space of the cup member 22, and includes a plurality of spaced apart recesses 38, 40, and 42, each of which is sized to receive a cosmetic product. The cover 12 is adapted to be detachably secured to (i.e., “snap onto”) the cup member 22 to cover the open second end. The cover 12 may also include a mirrored surface 60.

The Pflueger et al. reference does not disclose a cosmetic product including, among other recitations, “a cosmetic composition contained in [a] recess of [a] foam core, the cosmetic composition comprising a cosmetic substance contained within a tray . . . ,” as recited in Applicant’s amended independent claim 1. In the Office Action,

the rejection statement asserts that Pflueger et al. discloses “a cosmetic substance contained within a tray (it is noted that lipstick substance contained within a tray or tube).” Office Action at 2. Although Applicant does not completely understand that assertion, Applicant respectfully notes that the Pflueger et al. reference does not disclose or suggest above-recited subject matter. More specifically, the Pflueger et al. reference does not disclose a tray, and does not disclose a cosmetic composition contained within the tray. Therefore, the Pflueger et al. reference does not disclose, either expressly or inherently, all of the subject matter recited in Applicant’s independent claim 1. Accordingly, independent claim 1 is patentably distinguishable from the Pflueger et al. reference.

Section 103(a) Rejections

In the Office Action, claims 1, 4-8, 10-18, and 21-25 were rejected under § 103(a) based on Parkhurst (U.S. Patent No. 4,461,332) in combination with Pflueger et al., either alone or in combination with either Skarne or Gueret. Claims 1, 4, and 16 are the only independent claims rejected under § 103(a) based on the Office Action’s combination of those references. As discussed below, Applicant respectfully traverses each of the § 103(a) rejections at least because there is no suggestion or motivation to combine those reference teachings in the Office Action’s proposed, hypothetical manner. Therefore, Applicant respectfully submits that claims 1 and 3-26 are allowable at least for the reasons outlined in more detail below.

In the Office Action, independent claim 1 was rejected under § 103(a) based on Parkhurst in combination with Pflueger et al. The Office Action acknowledges that the Parkhurst reference does not disclose “the base, the cover and the hinge forming [sic]

at least partially of foam and the base and the cover having a plurality of recesses therein.” Office Action at 3. The Office Action asserts, however, that the Pflueger et al. reference discloses “a foam core . . . 14, [and] a plurality of recesses (38,42) formed in the foam core,” and thereafter concludes that “[i]t would have been obvious . . . to employ the foam material with a plurality of recesses as taught by Pflueger et al into the cosmetic product of Parkhurst for the purpose of providing shatterproof to the cosmetic product.” Id. at 3-4. Applicant respectfully traverses the § 103(a) rejection based on the Office Action’s proposed, hypothetical combination of the Parkhurst and Pflueger et al. references because the Office Action fails to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, among other requirements, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one having ordinary skill in the art, to modify the reference or to combine reference teachings.” M.P.E.P. § 2142. In other words, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Id. § 2143.01 (citation omitted). Furthermore, the M.P.E.P. advises that “[i]t is improper to combine references where the references teach away from their combination.” Id. § 2145(X)(D)(2) (citation omitted).

The Office Action fails to establish that Applicant’s independent claim 1 is *prima facie* obvious. As explained in more detail below, there is no suggestion or motivation to modify the Parkhurst reference’s disclosure in view of the Pflueger et al. reference since the Parkhurst reference teaches away from the hypothetical modification proposed in the Office Action.

The rejection statement asserts that “[i]t would have been obvious . . . to employ the foam material with a plurality of recesses as taught by Pflueger et al into the cosmetic product of Parkhurst for the purpose of providing shatterproof to the cosmetic product.” Office Action at 3-4. Applicant respectfully submits that the Parkhurst reference itself teaches away from that hypothetical, proposed modification to Parkhurst. In particular, the Parkhurst reference discloses a cosmetic bag or case 10 including a top cover portion 11 and a bottom cover portion 12, which may be hinged together. The top and bottom cover portions 11 and 12 may be formed of plastic, cloth, or some other suitable, flexible or rigid material. First hook and loop strap members 24 and 25 extend across at least part of the interior of the cosmetic bag 10. Second hook and loop strap members 26 and 27 are adapted for mating engagement with the first hook and loop strap members 24 and 25. Padding 40 is located adjacent the hook and loop strap members 24, 25, 26, and 27. The padding 40 may be formed of resilient rubberized carpet padding.

According to the Parkhurst reference, when a cosmetic article (e.g., article 44) is secured between the first and second hook and loop strap members 24, 25, 26, and 27, the article 44 resiliently and frictionally engages the padding 40 and is retained in a substantially immobile position within the cosmetic bag 10. Further, the Parkhurst reference teaches away from “other cosmetic bags or cases [that] have been adapted to hold articles secure[ed] in a pre-arranged array,” and the reference emphasizes that “[m]ost such bags make no provision for securing articles of odd sizes, or unusual shapes, or additional cosmetic articles selected by the bag user.” Col. 1, lines 25-36. In addition, the Parkhurst reference sets forth objects of the invention that concern an arrangement permitting a “bag user” to create (i.e., customize) a bag to carry an array of

virtually any number of articles of any size or shape. Col. 1, lines 46-48. In other words, the Parkhurst reference distinguishes its cosmetic bag 10 from others by stressing the significance of having no pre-arranged recesses. Therefore, there would not have been any suggestion or motivation to “employ the foam material [presumably of Parkhurst] with a plurality of recesses,” as asserted in the rejection statement, at least because the Parkhurst reference teaches away from such recesses.

Since Parkhurst teaches away from recesses, there is no suggestion or motivation to modify the Parkhurst reference’s disclosure in the hypothetical manner proposed in the Office Action. As a result, the Office Action has failed to establish a *prima facie* case of obviousness under the M.P.E.P.’s guidance, and Applicant’s amended independent claim 1 is patentably distinguishable from the Parkhurst and Pflueger et al. references, taken individually or in combination. Accordingly, Applicant’s independent claim 1 is not *prima facie* obvious, and therefore, the Office Action’s rejection under 35 U.S.C. § 103(a) based on Parkhurst in view of Pflueger et al. is improper and should be withdrawn.

Independent Claim 4

In the Office Action, Applicant’s independent claim 4 was rejected under 35 U.S.C. § 103(a) based on Parkhurst in combination with Pflueger et al. For reasons similar to those outlined above with respect to independent claim 1, the Office Action’s proposed, hypothetical combination of the Parkhurst and Pflueger et al. references fails to establish a *prima facie* case of obviousness. In particular, regardless of whether the references are considered alone or in combination, there is no suggestion of a product

including at least one recess, as recited in independent claim 4. Therefore, Applicant's independent claim 4 is patentably distinguishable from those references.

Independent Claim 16

In the Office Action, Applicant's independent claim 16 was rejected under 35 U.S.C. § 103(a) based on the Office Action's proposed, hypothetical combination of the Parkhurst, Pflueger et al., and Skarne references. For reasons similar to those outlined above with respect to independent claim 1, the Office Action's proposed, hypothetical combination of the Parkhurst and Pflueger et al. references fails to establish a *prima facie* case of obviousness. Furthermore, the Skarne reference fails to overcome the deficiencies of the Parkhurst and Pflueger et al. references. Therefore, Applicant's independent claim 16 is patentably distinguishable from the Parkhurst, Pflueger et al., and Skarne references.

New Independent Claim 26

Applicant's new independent claim 26 recites a cosmetic product including, among other recitations, a foam core, a cover, and "a hinge connecting the cover and the foam core" The Pflueger et al., Parkhurst, Skarne, and Gueret references, taken individually or in combination, fail to disclose or suggest at least that subject matter recited in Applicant's new independent claim 26. Therefore, new independent claim 26 is patentably distinguishable from those references.

Section 103(a) Rejections of Claims 3, 6, and 20

In the Office Action, dependent claims 3 and 6 were rejected under 35 U.S.C. § 103(a) based on Parkhurst combined with Pflueger et al. and Gueret. Claims 3 and 6 depend from independent claims 1 and 4, respectively. Therefore, those claims should be allowable for at least the same reasons claims 1 and 4 are allowable.

Furthermore, claim 20 was rejected under 35 U.S.C. § 103(a) based on Pflueger et al. By this Amendment, Applicant has amended independent claim 1, thereby obviating its rejection, as outlined previously herein. Since claim 20 depends from independent claim 1, the § 103(a) rejection of that claim has also been obviated.

Conclusions

For at least the reasons set forth above, independent claims 1, 4, 16, and 26 should be allowable. Dependent claims 3, 5-15, and 17-25 each ultimately depend from one of independent claims 1, 4, and 16. Consequently, those dependent claims should be allowable for at least the same reasons claims 1, 4, and 16 are allowable.

Therefore, Applicant respectfully requests the reconsideration of this application, the withdrawal of the outstanding claim rejections, and the allowance of claims 1 and 3-26.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned attorney at 571-203-2739.

Applicant respectfully submits that the Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether those

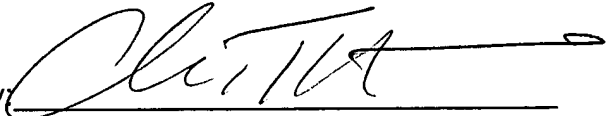
assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 6-0916.

Respectfully submitted,

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